

REMARKS

Claims 1-30 were pending in this application.

Claims 1-30 have been rejected.

Claims 1, 11, 12, 23 and 30 have been amended.

Claims 19-22 have been canceled.

Claims 31-32 have been added.

Claims 1-18 and 23-32 remain pending in this application.

Reconsideration and full allowance of Claims 1-18 and 23-32 are respectfully requested.

I. OBJECTIONS TO DRAWINGS

The Notice of Draftsperson's Patent Drawing Review attached to the Office Action indicated that the drawings were objected to by the Draftsperson. However, as no objection to the drawings was raised by the Examiner, the Applicant assumes that the informal drawings are acceptable to the Examiner for examination purposes. Applicant will submit formal drawings upon allowance of the present application.

II. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1, 2, 4-12 and 14-30 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,452,615 to Chiu et al. (“*Chiu*”). This rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Chiu recites a notetaking system that analyzes video to detect and segment slide changes in the video. During playback of the segmented video, a user can bookmark points in the video and add notes to the video. (*Chiu*, Col. 3, Lines 31-40; Col. 5, Lines 13-28; Col. 6, Lines 6-9 and Lines 59-61; and Col. 7, Lines 14-40). However, *Chiu* lacks any mention that the video segmenting is performed in response to a “bookmark signal” as recited in amended Claims 1, 11, 23 and 30. (Support for the amendments can be found on page 8, lines 8-11 and throughout the specification of the present application.) In *Chiu*, the video segmentation is performed prior to bookmarking or other editing by the user, and therefore, is not dependent on nor related to the bookmarking process.

Moreover, *Chiu* cannot be modified to perform the video segmentation in response to a bookmarking signal. The purposes of the video segmentation in *Chiu* are to create an easily

accessible set of notepages corresponding with slide changes and for frame rate compression to optimize the bandwidth used to transmit the segmented video from a server to a client. Performing the video segmentation in response to a bookmarking signal (in *Chiu*, bookmarking is performed by a user) would defeat both express purposes of *Chiu*. As a result, one of ordinary skill in the art would not modify *Chiu* to reach the Applicant's invention as recited in Claims 1, 11, 23 and 30.

For these reasons, *Chiu* fails to anticipate the Applicant's invention as recited in Claims 1, 11, 23 and 30. Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejection and full allowance of Claims 1, 2, 4-12, 14-18 and 23-30. Claims 19-23 have been canceled, thus rendering the rejection of these claims moot.

III. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 3 and 13 under 35 U.S.C. § 103(a) as being unpatentable over *Chiu* in view of U.S. Patent No. 6,285,361 to Brewer et al. ("*Brewer*"). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is

established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

As described above, *Chiu* fails to disclose, teach or suggest performing video segmenting in response to a "bookmark signal" as recited in Claims 1, 11, 23 and 30. In addition, the combination of *Chiu* and *Brewer* also fails to disclose, teach or suggest performing video segmenting in response to a "bookmark signal" as recited in Claims 1, 11, 23 and 30, from which Claims 3 and 13 depend.

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection and full allowance of Claims 3 and 13.

IV. NEW CLAIMS

The Applicant has added new Claims 31 and 32. The Applicant submits that no new matter has been added. The Applicant respectfully requests entry and full allowance of Claims 31 and 32.

V. CONCLUSION

As a result of the foregoing, the Applicant asserts that the claims in the application are in condition for allowance and respectfully requests an early allowance of such claims.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208. No extension of time is believed to be necessary. If an extension of time is needed, however, the extension is requested. Please charge the fee for the extension to Deposit Account No. 50-0208.

Respectfully submitted,

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